

REMARKS

Re-examination and reconsideration of the subject matter identified in caption, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the remarks which follow, are respectfully requested.

Claims 1-26 remain pending in this application. The allowance of claim 3 is acknowledged with appreciation.

Claims 1, 2, 5, 7, 9, 15-18 and 20-22 were rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,458,006 to Döenges et al. for the reasons given in paragraph (4) of the Office Action. Reconsideration of this rejection is respectfully requested for at least the following reasons.

The present invention relates to esters of acrylic or methacrylic acid and hydroxy-terminated aromatic polyester oligomers. Thus, the oligomers of the invention are derived from aromatic polyesters such as PET, i.e., aromatic polymers containing a repeating ester group in the main chain. Aromatic polymers containing repeating esters groups in side chains are not considered aromatic polyesters (note the attached definition from Alger's Polymer Science Dictionary).

Döenges et al. '006 relates to acrylic or methacrylic esters of aromatic polyols of formula (I) where R_1 is a naphthylene group, a biphenylidiyl group, a dinaphthylmethanediyl group or a group formed by two phenylene groups bridged by -O-, -S-, SO_2 - or an alkylene group substituted by, for example, a carboxylic acid alkyl group. Note column 2, lines 26-46 thereof. Representative examples of R_1 are set forth in Table 1

of the reference and compounds 11-14 and 22-27 contain aliphatic ester groups as side-chain constituents. Applicant has carefully reviewed the cited document and failed to find any disclosure therein of acrylic or methacrylic acid esters where R_1 is derived from an aromatic polyester. The reaction of phenols with alkylene oxides or styrene oxides or ethylene carbonates will not yield polyesters (column 3 lines 50-54).

The legal standard for a rejection under §102 is as follows:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Respectfully, Applicant disagrees with the statement in the Office Action that compounds of formula (I) of the reference "reads on the compounds of the instant claim 1." The compounds disclosed in Döenges et al. are not derived from aromatic polyesters.

For at least the aforementioned reasons, the §102(b) rejection should be reconsidered and withdrawn. Such action is earnestly requested.

Claims 4, 6, 8, 10-14, 19, 23 and 26 were rejected under 35 U.S.C. §102(b) as anticipated by, or alternatively, under 35 U.S.C. §103(a) as obvious over Döenges et al. '006 for the reasons provided in paragraph (7) of the Office Action. Reconsideration of these rejections is respectfully requested for at least the reasons which follow.

As discussed above, the compounds defined in formula (I) of the reference and those specifically described in Table I and the working examples of Döenges et al. '006 are

not aromatic polyesters as that term is defined in the present specification and understood by those of ordinary skill in the art. Nor is there any disclosure or suggestion therein which would motivate those of ordinary skill to use aromatic polyesters to prepare the acrylic or methacrylic esters. Further, there is no reasonable expectation that the use of aromatic polyesters would be successful in achieving the results desired by patentees.

With specific regard to claim 6, for example, Applicant can find no disclosure in Döenges '006 which mentions PET as a possible reactant.

For at least the aforementioned reasons, the §102(b) and §103(a) rejections of claim 4, 6, 8, 10-14, 19, 23 and 26 over Döenges '006 is believed to be unsound and should be withdrawn. Such action is respectfully requested.

Claims 13 and 14 stand rejected under 35 U.S.C. §103(a) as unpatentable over Döenges et al. '006 for the reasons given in paragraph (8) of the Office Action. Reconsideration of this rejection is requested for at least the following reasons.

As fully discussed above, Applicant can find no disclosure or suggestion in the reference that aromatic substituent R_1 in formula (I) of the reference can be derived from an aromatic polyester such as PET. Regardless of the process used to prepare the presently claimed oligomers, the claims specify that substituent R_1 "is a repetition unit of an aromatic polyester". Since Döenges et al. '006 fails to disclose or suggest compounds where R_1 is a repetition unit of an aromatic polyester, the reference fails to render claims 13 and 14 *prima facie* obvious.

For at least the aforementioned reasons, the §103(a) rejection of claims 13 and 14 should be withdrawn and such action is requested.

Applicants note that claims 24 and 25 were not rejected on prior art. If these claims are allowable, the Examiner is requested to so indicate in the next communication from the Patent Office.

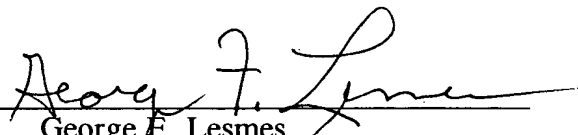
From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (703) 838-6683.

Respectfully submitted,

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